



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/846,658	05/01/1997	JOHN ROBERT ADAIR	CARP-0057	9631

7590

08/28/2002

FRANCIS A PAINTIN  
WOODCOCK WASHBURN KURTZ  
MACKIEWICZ AND NORRIS  
ONE LIBERTY PLACE 46TH FLOOR  
PHILADELPHIA, PA 19103

EXAMINER

DAVIS, MINH TAM B

ART UNIT

PAPER NUMBER

1642

DATE MAILED: 08/28/2002

13

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

08/846,658

Applicant(s)

ADAIR ET AL.

Examiner

MINH-TAM DAVIS

Art Unit

1642

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 May 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 8 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 24 June 2002. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.Claim(s) objected to: none.Claim(s) rejected: 24-31.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Effective February 7, 1998, the Group Art Unit location has been changed, and the examiner of the application has been changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Minh-Tam Davis, Group Art Unit 1642.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Accordingly, claims 24-31 are being examined.

The following are the remaining rejections.

### **REJECTION UNDER 35 USC 102(e)**

Rejection under 35 USC 102(e) of claims 24-31 pertaining to anticipation by Queen et al remains for reasons already of record in paper No.39.

Applicant argues that the Examiner's position, that there is support for CDRs as defined by Chothia et al in Queen '975, is contrary to what was argued by the patentees themselves during prosecution of the European equivalent of the Queen patent.

Applicant recites various passages on pages 6-7 of the paper filed July 13, 2001 by Protein Design Labs in EP 0 682 040, Exhibit 6.

Applicant's arguments set forth in paper No.41 have been considered but are not deemed to be persuasive for the following reasons:

Contrary to Applicant's assertion, the Examiner's position, that there is support for CDRs as defined by Chothia et al in Queen '975, is not contrary to what was argued

Art Unit: 1642

by the patentees themselves during prosecution of the European equivalent of the Queen patent. Pages 6-7 of Exhibit 6 concern how one would interpret claim 1 in a divisional of Queen's European patent 0 451 216 B1, which is not relevant to the issue of whether there is support for CDRs as defined by Chothia et al in Queen '975. Further, the paragraph "nowhere does the contest Patent state that the Chothia definition is to be used in carrying out the invention or in understanding the claims" does not support the implication that Queen et al state that the specification of Queen '975 does not have support for the Chothia definition, since said paragraph clearly seems to be referred to the content of the added passage to Queen's European patent 0 451 216 B1, which has been alleged by some the Opponents as altering and adds to the meaning of claim 1 (see page 5 of Exhibit 6).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MINH-TAM DAVIS whose telephone number is 703-305-2008. The examiner can normally be reached on 9:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ANTHONY CAPUTA can be reached on 703-308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications.

Application/Control Number: 08/846,658


Page 4

Art Unit: 1642

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0916.

MINH TAM DAVIS

August 26, 2002

  
SUSAN UNGAR, PH.D  
PRIMARY EXAMINER